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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/821,757	03/30/2001	Philipp Albert	41724W003	5161

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EXAMINER
YOON, TAE H

ART UNIT	PAPER NUMBER
1714	

DATE MAILED: 09/27/2002

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.	Applicant(s)
09/821,757	Albert et al
Examiner	**Group Art Unit**
T. Yoon	1714

—The MAILING DATE of this communication appears on the cover sheet beneath the correspondence address—

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE THREE MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, such period shall, by default, expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

☒ Responsive to communication(s) filed on 1-10-02.

☐ This action is **FINAL.**

☐ Since this application is in condition for allowance except for formal matters, **prosecution as to the merits is closed** in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 1 1; 453 O.G. 213.

Disposition of Claims

☒ Claim(s) 1-20 is/are pending in the application.

Of the above claim(s) _____ is/are withdrawn from consideration.

☐ Claim(s) _____ is/are allowed.

☒ Claim(s) 1-20 is/are rejected.

☐ Claim(s) _____ is/are objected to.

☐ Claim(s) _____ are subject to restriction or election requirement

Application Papers

☐ The proposed drawing correction, filed on _____ is ☐ approved ☐ disapproved.

☐ The drawing(s) filed on _____ is/are objected to by the Examiner

☐ The specification is objected to by the Examiner.

☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. § 119 (a)–(d)

☒ Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119 (a)–(d).

☒ All ☐ Some* ☐ None of the:

☒ Certified copies of the priority documents have been received.

☐ Certified copies of the priority documents have been received in Application No. _____.

☐ Copies of the certified copies of the priority documents have been received in this national stage application from the International Bureau (PCT Rule 17.2(a))

*Certified copies not received: _____.

Attachment(s)

☐ Information Disclosure Statement(s), PTO–1449, Paper No(s). _____

☒ Notice of Reference(s) Cited, PTO–892

☐ Notice of Draftsperson's Patent Drawing Review, PTO–948

☐ Interview Summary, PTO–413

☐ Notice of Informal Patent Application, PTO–152

☐ Other _____

Office Action Summary

Note new examiner in charge of the case.

Allowabilty indicated in the last office action is withdrawn due to new ground of rejection.

The following is a quotation of the first paragraph of 35 U.S.C. 112:

> The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

Claims 1-20 are rejected under 35 U.S.C. 112, first paragraph, as containing subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention.

Incomplete structure is disclosed and claimed. See line 15, page 5 of the specification wherein the siloxane group in the bracket k is missing one radical. Thsu, applicant failed to describe adequately said structure. Note that the introduction of new matter is prohibited.

The claims are not commensurate in scope with an enabling disclosure until the named groups for "substituted", as described in the instant specification, are recited in the claims for "substituted". If there are no examples for "substituted", in the instant specification, "substituted" must be cancelled because the specification is not enabling for the skilled artisan to practice the invention. It would require undue experimentation to determine all of the groups which are encompassed by "substituted" and how to attach these groups to the claimed compound.

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 10 and 15 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

The recited "**ormocer**" in claim 10 is a trademark, and the use of trademarks and tradenames in the claims is improper because the manufacturer is under no obligation to continue making the same material under a given trademark nor to continue selling anything under a given trademark. The discontinued use of the trademark or the changing of the material sold under the trademark renders the claim meaningless. See MPEP 608.01(v).

The recited "Usual aditives" in claim 15 is indefinite, especially in view the recited "consisting of".

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

> A person shall be entitled to a patent unless -
>
> (b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.
> (e) the invention was described in a patent granted on an application for patent by another filed in the United States before the invention thereof by the applicant for patent, or on an international application by another who has fulfilled the requirements of paragraphs (1), (2), and (4) of section 371(c) of this title before the invention thereof by the applicant for patent.

The changes made to 35 U.S.C. 102(e) by the American Inventors Protection Act of 1999 (AIPA) do not apply to the examination of this application as the application being examined was not (1) filed on or after November 29, 2000, or (2) voluntarily published under 35 U.S.C. 122(b). Therefore, this application is examined under 35 U.S.C. 102(e) prior to the amendment by the AIPA (pre-AIPA 35 U.S.C. 102(e)).

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

Claims 1-7 and 9-16 are rejected under 35 U.S.C. 102(b) as anticipated by or, in the alternative, under 35 U.S.C. 103(a) as obvious over Yang et al (US 5,969,000).

Note that the instant formula (I) encompasses the ethoxylated bisphenol A dimethacrylate and polycarbonate dimethacrylate condensation product (table on col. 6) of Yang et al. Filled compositions comprising various fillers including silane treated silica are taught at col. 6, lines 29-67. The recited physical properties in claims 14 and 17 are inherent in the composition of Yang et al. Thus, the instant invention lacks novelty.

Claims 1-7 and 9-16 are rejected under 35 U.S.C. 102(b) as anticipated by or, in the alternative, under 35 U.S.C. 103(a) as obvious over Erdrich et al (US 5,708,051), Schmitz-Josten et al (US 4,177,563), Lai (5,081,164) or Ibsen et al (US 4,859,716).

Erdrich et al teach the instant invention at col. 4, line 29 to col. 5, line 50 and in examples. Schmitz-Josten et al, Lai and Ibsen et al teach the same in examples. The recited physical properties in claims 14 and 17 are inherent. Thus, the instant invention lacks novelty.

Claims 1-10 and 12-16 are rejected under 35 U.S.C. 102(b) as anticipated by or, in the alternative, under 35 U.S.C. 103(a) as obvious over Palazzotto (US 4,889,792) or Oxman et al (5,980,253).

Palazzotto teaches the instant invention in claims and at col. 2, line 14 to col. 3, line 11 and col. 5, lines 14-15 and 33-46. The recited physical properties in claims 14 and 17 are inherent. Oxman et al teach the same in examples. Thus, the instant invention lacks novelty.

Claims 1-16 are rejected under 35 U.S.C. 102(e) as anticipated by or, in the alternative, under 35 U.S.C. 103(a) as obvious over Trom et al (US 6,555,725).

Trom et al teach the instant invention in examples and at col. 6, line 66 to col. 7, line 17. The recited physical properties in claims 14 and 17 are inherent. Thus, the instant invention lacks novelty.

Claims 1-7, 9, 10 and 12-16 are rejected under 35 U.S.C. 102(e) as anticipated by or, in the alternative, under 35 U.S.C. 103(a) as obvious over Rheinberger et al (US 6,180,688).

Rheinberger et al teach the same in examples. The recited physical properties in claims 14 and 17 are inherent. Thus, the instant invention lacks novelty.

Claims 1-16 are rejected under 35 U.S.C. 103(a) as obvious over Yang et al (US 5,969,000), Erdrich et al (US 5,708,051), Schmitz-Josten et al (US 4,177,563), Lai (5,081,164) or Ibsen et al (US 4,859,716) in view of Palazzotto (US 4,889,792) or Oxman et al (5,980,253).

The instant invention further recites an iodonium salt and a sensitizer over the primary references. However, the instant photo-curing polymerization initiators well known in the art as taught by Palazzotto and Oxman et al.

It would have been obvious to one of ordinary skill in the art at the time of the instant invention to utilize an iodonium salt and a sensitizer of Palazzotto or Oxman et al in Yang et al , Erdrich et al, Schmitz-Josten et al, Lai or Ibsen et al since such polymerization initiator system is routine in the art, or to use silane-treated fillers of Yang et al , Erdrich et al, Schmitz-Josten et al, Lai or Ibsen et al in Palazzotto or Oxman et al since the use of silane coupling agents on fillers in order to increase compatibility of said filler and a matrix resin is well known practice in the art.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Tae H. Yoon whose telephone number is (703) 308-2389. The examiner can normally be reached on Monday to Thursday from 8:00 to 5:30.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Vasu Jagannathan, can be reached on (703) 306-2777. The fax phone number for the organization where this application or proceeding is assigned is (703) 872-9310.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 308-0661.

THY/September 25, 2002

TAE H. YOON
PRIMARY EXAMINER